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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,035	02/05/2004	Teodzyj Kolasa	7283.US.01	6968

23492 7590 03/29/2007  
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ABBOTT PARK, IL 60064-6008

EXAMINER
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BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/29/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

### Office Action Summary

Application No.

10/773,035

Applicant(s)

KOLASA ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-39,49-52,55-62 and 70-96 is/are pending in the application.
- 4a) Of the above claim(s) 12-17,21-31,39,49-52,55-62 and 70-96 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,32-36 and 38 is/are rejected.
- 7) ☒ Claim(s) 6-11,18-20 and 37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

In view of applicants' response filed 12/26/06 the following applies.

Nonelected subject matter remains in the claims. Note the examiner's comment made on p.2, first paragraph of the previous action.

Claims 5 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. In amending the claims these two claims have been made dependent on claim "41" which appears to be a typo. However its not clear if "4" or "1" was really intended.

Claim 18 is objected to because of the following informalities: The claim as now presented has extraneous matter added to it. See "andkl" on the 2<sup>nd</sup> line. Appropriate correction is required.

Claims 33-36 and 38 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement for reasons given previously. The examiner has emphasized that the level of skill in the art is low not high in getting dopamine agonists to work for all types of sexual dysfunction which are many and arise from different origins. The passage pointed out by applicants in the online article is noted but is

not indicative of any type of correlation with D4 agonists in particular, which the instant compounds are asserted to be or any type of preclinical trials showing a reasonable correlation for *in vivo* efficacy. It appears at best to be directed to apomorphine's ability to "emerge in the treatment of women with sexual aversion and arousal disorder." However apomorphine is known as a D2 agonist. Additionally, increasing female sexual arousal is but one type of disorder considered part of FSD as discussed on p.4 of the article.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,3,4, 5 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buzas in view of Buzas for reasons of record. Note that generic claims 1,3,4 and 32, previously not included in this rejection are now included due to applicants' amendment to main claim 1 including H for R<sub>B</sub>. Applicants' rebuttal appear to be that there is no suggestion to arrive at applicants' claimed invention but the examiner has shown where equivalency teachings exist in the secondary reference to arrive at applicants' compounds. The fact that the applied art teaches a different use is irrelevant in rejecting compound/composition claims. Applicant must

prove that their compound(s) possess a property that the prior art compound(s) do not possess- **not** is not disclosed to possess. See In re Best 195 USPQ 430; In re Dillon 16 USPQ 2d 1897. Applicants mention they can show unexpected results for instant compounds having L as  $(CH_2)_2$  but no comparative data in verified form is seen for instant compounds vs prior art compound no.1 in Buzas (GB'523). However, for any consideration of such evidence after final ,compliance with 35 CFR 1.116 must be met.

Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. There is at least one species not within the scope of claim 1. Note the nicotinonitrile species on p.9. Other similar species have been cancelled by applicants.

Claims 6-11,18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-

272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Emily Bernhardt  
Primary Examiner  
Art Unit 1624